UNITED STATES DEPARTMENT OF COMMERCE
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R-1985-1

September 20, 1985

In re examination of : DECISION ON PETITION
: FOR SUPERVISORY
: REVIEW OF DECISION
: ON REGRADE

This is a decision on your petition under 37 CFR 1.181 filed September 4, 1985 for supervisory review of the Decision on Regrade by the Director of Enrollment and Discipline for the examination held on April 9, 1985. You contend that the Director erred in his conclusions in the Decision and request that his decision be reversed and that six points deducted for Question 3 of the afternoon section of the examination be added to your score. You argue that the Director's position requiring only a showing of error without deceptive intent on the part of the omitted inventor is incorrect and that the Director's position is not supported by case law or legislative intent. The grader deducted six points because 35 U.S.C. 116 requires lack of deceptive intent on the part of Hardy and because you did not recognize that conversion was still possible under 35 U.S.C. 116.

In your answer to Question 3, you immediately concluded that Smith acted with deceptive intent and that this "unfortunate situation may not be remedied by amendment, affidavit or otherwise, since Hardy was intentionally omitted as a named inventor on the original application." Since you concluded that Smith's act was intentional, you reasoned that no showing could be made under 35 U.S.C. 116 because you could not show that the error arose without deceptive intent on the part of the inventors, i.e. Smith and Hardy.

Your answer is based on your conclusion that the act by Smith was intentional and, therefore, deceptive. The facts in the question reveal that Smith was named as sole inventor in a patent application and that Smith knew he was a co-inventor

before the application was filed. These facts alone do not establish clear and convincing evidence that Smith acted with deceptive intent. The facts do give rise to an inquiry to ascertain his intent. But a conclusion that he acted with deceptive intent is premature. Such a conclusion must be based on all of the facts and circumstances surrounding the execution of the application as well as Smith's background and knowledge with respect to patent law and patent prosecution. Like Mr. Jones, Smith may not have known all the requirements for filing a patent application at the time of execution. There are not enough facts presented in the question to draw a conclusion that the evidence is clear and convincing that Smith intentionally omitted Hardy as an inventor. Therefore, the grader properly deducted six points for your answer to Question 3 because conversion of the inventorship is possible under 37 CFR 1.48 and 35 U.S.C. 116, notwithstanding the fact that Smith knew he was a joint inventor at the time the application was filed and because your answer did not set forth all of the requirements of 37 CFR 1.48 for amending the inventorship.

For the reasons given above, your request for six additional points is denied.

Original signed by
Donald J. Quigg

Donald J. Quigg
Commissioner of Patents
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